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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/660,027

09/11/2003

Susann Marie Keohane

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EXAMINER

LONG, ANDREA NATAE

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/660,027

Applicant(s)

KEOHANE ET AL.

Examiner

Andrea N. Long

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 8, 11, 15, 18 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1, 4, 8, 11, 15, 18 and 21-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Applicant's Response***

1. In Applicant's Response dated 09/26/2006, Applicant amended independent claims 1, 8, and 15, added new claims 21-23 and cancelled claims 2, 3, 5-7, 9, 10, 12-14, 16, 17, 19, and 20, and argued against of rejections previously set forth in the Office Action dated 06/26/2006.

Objection to claim 11 is moot, due to applicant amending the claim.

The remarks on page 7 paragraph 2 filed 09/26/2006 indicate that claims 16-20 have been cancelled, however, it appears that claim 18 has not been cancelled and is rejected as noted below.

Examiner has provided another copy of "Special Edition Using Microsoft Windows 98, 2<sup>nd</sup> Edition, 2000", which now includes reference marks for ease of comprehension. Also note that additional pages have been included to address the limitation in the newly added claims 21-23.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4, 8, 11, 15, and 18 remain rejected and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bott et al (Special Edition Using Microsoft

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Windows 98, 2<sup>nd</sup> Edition, 2000), hereinafter, "Bott" in view of Grossman et al (US Patent 5564004), hereinafter, "Grossman".

As to independent claims 1, 8, and 15,

Bott discloses *facilitating an icon* (page 5 paragraph [009] → Bott discloses that an icon is used to designate a file type or folder, which he uses the terms "file type" and "file folder" throughout his teachings to be equivalent to an icon) *selection from a plurality of icons* (page 3 paragraphs [004] [005] → Bott discloses using a tool which locates a file on a computer for selection) *on a desktop, the desktop being a screen of a computer system that simulates an office desktop on which various objects represented each by an icon are displayed, the various objects including a file folder within which at least one icon representing a file with an extension is stored* (page 3 paragraphs [006] [006C] → Bott discloses that the files can be located and selected from the Desktop folder, which is well known in the art to be a replica of the desktop, which holds all icons located on the desktop). Furthermore, it was also well known in the art, in which the applicant admits in the specification, page 1 lines 14-29, stating the definition of a desktop as it relates to Microsoft Windows operating system.

*the method comprising the steps of:*

*enabling a user to enter a file extension, the file extension being an extension of a file being represented by an icon to be selected* (page 3 paragraph [004] → Bott discloses that the user can locate and select a file by entering a fragment of text within the file, a fragment which can include an extension of a file);

*comparing the entered file extension with file extensions of all files represented by an icon on the desktop, including the file extension of the files stored in the file folder, to determine icons* (page 2 paragraphs [001] [002], page 4 [007] → Bott discloses comparing the text entered to locate and select the file, to every file and file folder which contains a file that matches on the specified location, which is the desktop. By comparing the files, it should also be considered determining files in which the user will perform a function)

However, Bott does not teach *migrating icons towards a pointing device, the pointing device for selecting one of the migrated icons*. Grossman teaches *migrating icons towards a pointing device* (column 4 lines 34-38, column 5 lines 1-2 → Grossman discloses a technique which allows icons to move towards a cursor, the cursor which is controlled by a mouse), *the pointing device for selecting one of the migrated icons* (column 6 lines 8-11 → Grossman discloses that the mouse is used to select the icon that has moved towards the cursor).

It would be obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of migrating icons towards a pointing device of Grossman, with the comparing icon extensions for facilitating an icon selection of Bott. The motivation is expressed by Grossman (column 1 lines 35-44), where he discusses moving through the many icons on a display and selecting a particular icon can be tedious for ordinary users. Grossman also states that there was a need for users to

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easily locate and select a particular icon. Further, Grossman states it is quite difficult for those users with manual dexterity problems to navigate through a complex task and the many icons to select the intended function. Therefore using a pointing device and automatically moving the icons would have made this much easier for users to navigate through a plurality of icons.

As to claims 4, 11, and 18,

Grossman teaches *wherein the pointing device is a mouse pointer* (column 4 lines 34-38 → Grossman teaches that a mouse controls the position of a cursor).

As to claims 21-23,

Bott discloses *opening folders to display icons stores therein* (page 6 paragraph [010] → Grossman teaches by clicking on the icon of a folder, the contents of that folder appear). Bott does not teach *icons migrating toward a pointing device*. Grossman teaches *icons migrating toward a pointing device*, as describe above. The step of opening the folder to display additional icons and having those additional icons migrate to a pointing device is just an additional level of facilitating an icon selection of the independent claims rejected above, which was obvious and provides the same motivation of users ease of selecting a particular icon.

### ***Response to Arguments***

4. Applicant's arguments filed September 26, 2006 have been fully considered but they are not persuasive.

As to claims 1, 8, and 15 applicant argues that Bott et al do not teach,

*the steps of comparing entered file extension with file extensions of all files represented by an icon on the desktop, including the file extension of the file stored in the file folder, to determine icons to migrate toward a pointing device, the pointing device for selecting one of the migrated icons;, and migrating the icon representing the file folder toward the pointing device if, based on the comparing step, the file extension of the file stored in the file folder is equal to the file extension entered, thereby facilitating the icon selection of the icon representing the file stored in the migrated file folder as claimed.*

Applicant further argues that Grossman et al do not teach,

*the steps of comparing entered file extension with file extensions of all files represented by an icon on the desktop, including the file extension of the file stored in the file folder, to determine icons to migrate toward a pointing device, the pointing device for selecting one of the migrated icons;, and migrating the icon representing the file folder toward the pointing device if, based on the comparing step, the file extension of the file stored in the file folder is equal to the file extension entered, thereby facilitating the icon selection of the icon representing the file stored in the migrated file folder as claimed.*

5. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections

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are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

6. The examiner disagrees. Bott discloses *comparing entered file extension with the file extensions of all files represented by an icon on the desktop, including the file extension of the file stored in the file folder*. Page 4 paragraph [007], discloses in detail, that Windows compares the text you enter in the Named box with the name of every file and folder in the specified location. While the applicant argues that Bott does not teach *to determine icons*, the applicant's specification lacks to define determining icons. Therefore, the Examiner interprets determining and comparing of icons would have been equivalent actions.

Grossman teaches *icons migrating towards a pointing device, the pointing device for selecting one of the migrated icons*. Column 4 lines 34-38, column 5 lines 1-2, column 6 lines 8-11, teaches, as admitted by applicant, determining which ones of a plurality of icons displayed on a screen move towards a cursor located on the computer display. Further, Grossman teaches the icon selection is made by using a mouse.

The motivation for combining the "comparing icon extensions" for facilitating an icon selection of Bott, with the teachings of migrating icons towards a pointing device of



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Grossman, the same as the applicants use of the invention which would have made it easier for a user to locate and select a particular icon.

### ***Conclusion***

**7. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

This action is a **final rejection** and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed. The Notice of Appeal must be accompanied by the required appeal fee.

If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea N. Long whose telephone number is 571-270-1055. The examiner can normally be reached on Mon - Thurs 7:30 am to 5:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andrea N. Long  
10/19/2006

  
WILLIAM BASHORE  
PRIMARY EXAMINER

  
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